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PATENTS
CF-007R

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

REISSUE PATENT APPLICATION

Reissue :
Applicants/Appellants : Stuart A. Fraser et al.
Application No. : 09/859,661 Confirmation No. 3933
Filed : May 17, 2001
For Reissue of : 5,905,974
Patent No.
Issued : May 18, 1999
For : AUTOMATED AUCTION PROTOCOL PROCESSOR
Examiner : James W. Mhyre
Group Art Unit : 3622

New York, New York 10020
April 7, 2005

Hon. Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

REPLY BRIEF UNDER 37 C.F.R. § 41.41

Sir:

Pursuant to 37 C.F.R. § 41.41, applicants/appellants file this Reply Brief in reply to the Examiner's Answer of January 7, 2005 rejecting claims 1-5, 7-23 and 31-37 pending in this application. A one-month extension of the two-month period of 37 C.F.R. § 41.41(a)(1) for filing this Reply was

agreed to in a telephone conference with S.P.E. Stamber on March 3, 2005. Applicants/appellants filed a Petition Under 37 C.F.R. §§ 41.41(c) and 1.136(b) for Extension of Time on March 3, 2005 pursuant to the telephone conference.

In view of the arguments and authorities set forth below, this Board should find the rejection of claims 1-5, 7-23 and 31-37 of this application to be in error and should reverse it. Claims 1-5, 7-23 and 31-37 are patentable.

I. SUMMARY OF EXAMINER'S ANSWER

In the Examiner's Answer, the Examiner recites again the rejections made in the final Office Action of October 3, 2003. While most of the recitation is a verbatim copy of those rejections from the final Office Action, the Examiner modified the original grounds of rejection of claims 16-18 and 18-23 (Examiner's Answer, pp. 10-12), and has embellished his argument with respect to the rejections of claims 16-23, but did not designate any portion of the Examiner's Answer as a new ground of rejection under 37 C.F.R. § 41.39(a)(2).¹

Finally, the Examiner has responded to the arguments set forth by applicants/appellants in the Appeal Brief filed October 25, 2004.

¹ This Reply Brief address the merits of those modified and embellished rejections. If the Board believes that applicants/appellants should have treated the modified rejection as a new ground of rejection, applicants/appellants respectfully request that they be given a time period in which to satisfy the requirements of 37 C.F.R. § 41.39(b)(2) by filing a Supplemental Reply Brief which, in addition to addressing the new ground of rejection, incorporates all the requirements of § 41.37(c).

II. RELATED LITIGATION

On February 21, 2005, a verdict was rendered by the jury in the U.S. District Court for the District of Delaware in the litigation styled eSpeed, Inc. et al. v. BrokerTec USA, L.L.C. et al., D. Del., Civil Action No. 03-612(KAJ). This litigation is based on U.S. Patent No. 6,560,580 which issued from a continuation of the application that matured into the patent in reissue. Applicants/appellants submit herewith an Information Disclosure Statement disclosing the specifics of the verdict as well as other pertinent details of the litigation. Applicants/appellants respectfully request that the Board consider the Information Disclosure Statement together with this Reply Brief.

III. ARGUMENT

A. The Claimed Invention

Applicants/appellants have already described the claimed invention in the Appeal Brief. However, applicants/appellants believe that the following abridged description of the invention will be useful in considering the discussion below.

One embodiment of the invention relates to a data processing system for implementing a structured trading environment for transacting the purchase and sale of select items having a predetermined set of characteristics. The data processing system is operated by a plurality of trading participants through a communication platform to permit exchanging offers and bids and for receiving select participant trade commands relating to the items.

The data processing system includes a plurality of workstations comprising a display means for presenting to a participant information about pending market conditions as

they relate to the items being traded and bids and offers entered by other participants in regard to the items. The data processing system also includes a server, in communication with the workstations, programmed to support a predetermined trading control logic. The trading control logic comprises a protocol of trade sequences initiated from a bid/offer state by a participant hit or lift trade command. The protocol is directed to execute trade commands from the participants in a predefined way corresponding to a plurality of trade states defining the ability of various participants to participate in trading activity.

In some embodiments of the invention, the system includes a plurality of trade execute keys, programmed to be individually assigned to a particular security available for trading. In the above-captioned patent-in-reissue, examples of trade execute keys are the Main Function Keys BUY (or SELL) - each of which is assigned to a different one of four securities (Bond Basis, Triple Old Bond, Old Bond, and Bond). As shown in the drawings of the patent in reissue (e.g., Figure 3), pressing one key (a BUY key or a SELL key) causes a trade to be executed for the particular security to which the key is assigned.

By contrast, in conventional trading systems, trade execution requires other functions than those described with respect to trade execute keys according to the present invention. McCausland, for example, requires first pressing a key to highlight on a display the issue desired to be traded, then pressing a HIT key or a TAKE key which, in turn, provides the trader the opportunity to change the trade, then pressing ENTER which, in turn, causes the trade to be displayed, and

then pressing CONFIRM or REJECT. It can be seen that functions associated with trade execution performed by legacy systems are far different from functions performed by trade execute keys according to the invention.

IV. ARGUMENT

A. The Rejections of Claims 1-5, 7-15, and 34-36 Under 35 U.S.C. § 112

The Examiner's Answer maintains the rejection under 35 U.S.C. § 112 of claims 1-5, 7-15, and 34-36, and alleges, "the specification does not support nor disclose any steps that could be used to determine what the participant may have intended when he entered a bid/offer . . ." (emphasis added). Examiner's Answer, page 14.

At page 27, line 2 to page 30, line 9 of the Appeal Brief, appellants/appellants discussed the support for the claimed language. The Examiner's Answer stated, in response, that "[c]reating a Second Look State based on the time between the bids/offers is not determining that the aggressor participant's bid/offer is in excess of what the participant may have intended." Id.

Applicants/appellants respectfully disagree. The claim language in question is ". . . trading control logic, in response to detecting that an aggressor participant's hit or lift trade command would execute a trade in excess of what the aggressor participant may have intended, automatically enables the aggressor participant to decline, prior to execution, at least a portion of only the excess part of the trade." In one embodiment of the Second Look State described in the specification, and quoted in the Appeal Brief, the invention

detects the following circumstances: (a) the aggressor participant pressed a trade command key to execute a trade on a bid or offer in the system and (b) the system determined that, for example, the size of the bid or offer increased within a certain time period prior to the trade command key being pressed.

In response to those circumstances, the invention gives the aggressor participant the opportunity to verify which one of two possible outcomes he intended when he pressed the trade command key. The first possible outcome is that the aggressor participant intended to trade the amount actually traded -- i.e., the bid or offer as changed. The second possible outcome is that the aggressor participant intended to trade against the amount designated by the previous (prior to the change) bid or offer.

The claim requires no further determination of the aggressor participant's intention and, therefore, no description of artificial intelligence or "fuzzy logic" in the specification is required to support the claim.

Thus, each and every step of the invention as claimed is supported by the specification. Because claim 1 is fully supported, the rejection under 35 U.S.C. § 112 of claims 1-5, 7-15, and 34-36 should be reversed.

B. The Rejections of
Claims 1-5, 7-18, 20-23
and 34 Under 35 U.S.C. § 102(b)

The Examiner's Answer also maintains the rejection of claims 1-5, 7-18, 20-23 and 34 under 35 U.S.C. § 102(b) as being separately anticipated by the McCausland reference and the Kramer reference.

Applicants/appellants responded in the Appeal Brief at

pages 31-35 to all the issues currently raised with respect to "states" by the Examiner's Answer.

With respect to the last element of claim 1 -- i.e., that in response to detecting that an aggressor participant's hit or lift trade command would execute a trade in excess of what the aggressor participant's hit or lift trade command may have intended, the method automatically enables the aggressor participant to decline, prior to execution, at least a portion of only the excess part of the trade -- the Examiner's Answer alleges that select portions of Kramer show such a trading method.

Specifically, the portions of Kramer include disclosure that the system tracks the time between the receipt of the trades (from the buyer and seller) and automatically identifies trades with "time marking differentials exceeding an acceptable level" (col 6, lines 48-52). Examiner's Answer, page 17. Also alleged was that the trader may use the keys on the portable device (PTS) "for automatically negating a transaction and for automatically voiding a transaction" (col. 5, lines 57-59. Id. Based on these two cited portions of Kramer, the Examiner concludes that "it is disclosed that the system will verify that the time does not exceed a designed limit (such as the argued 2 seconds) and will allow the trade to decline (negate or void) the transaction prior to execution." Id.

Throughout the prosecution of the above-captioned application, applicants/appellants have expressed their belief that Kramer does not show or

suggest a trading system that executes trades. Despite numerous invitations, the Examiner has never pointed out language in Kramer to the contrary. Therefore, applicants/appellants believe that, as a threshold matter, Kramer does not disclose a trading system that allows participants to execute a trade.

Furthermore, with respect to the cited portions of Kramer, the Examiner has taken two disparate teachings of Kramer and used the hindsight provided by applicants/appellants' invention to allegedly anticipate the subject matter of claim 1. The first portion of Kramer relates to verifying "time marking differentials exceeding an acceptable level." Kramer, col. 6, lines 51-52. It is assumed, though it is not clear from Kramer, that the differentials refer to different recording times of participating traders. The second portion of Kramer relates to a subsystem for erasing trade records that did not occur or correcting trade records for trades were reported incorrectly. Even putting the two pieces of Kramer together according to the logic of the Examiner does not produce the claimed element of automatically enabling the aggressor participant to decline, prior to execution, at least a portion of only the excess part of a trade in response to detecting that an aggressor participant's hit or lift trade command would execute a trade in excess of what the aggressor participant's hit or lift trade command may have intended because the system of Kramer is not a trading system -- it only records past trades.

Moreover, the Federal Circuit has affirmed the rule that, "[w]hen a claimed invention is not identically disclosed in a reference, and instead requires picking and choosing among a number of different options disclosed by the reference, then the reference does not anticipate." Mendenhall v. Astec Industries, Inc. 13 USPQ2d 1913, 1928 (Tenn. 1988), aff'd, 13 USPQ2d 1956 (Fed. Cir. 1989).

In addition, the Examiner's combination of the two disparate portions of Kramer to create the method of the invention is the result of impermissible hindsight. The Examiner is using the inventor's own invention against him by taking pieces of the prior art -- i.e., the Kramer reference -- and combining them in the manner the pieces are combined in the invention. This approach of combining disparate teachings, even if the teachings are found within the same reference, has been proscribed by the Court of Appeals for the Federal Circuit. See Al-Site Corp. v. VSI International Inc. 50 USPQ2d 1161, at 1171 (Fed. Cir. 1999) (citing W.L. Gore & Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1553 (Fed.Cir. 1983) ("To imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher." (emphasis added)))

It follows that because Kramer does not show trade execution, does not disclose giving the ability to

reject a portion of the excess amount that increased above the bid or offer size displayed prior to the execution of the trade (as described in more detail above), and because the Examiner has cobbled together disparate and unrelated portions of Kramer to anticipate the invention as defined by claim 1, claim 1 is not anticipated and the rejection of claim 1 should be reversed. The rejections of the dependent claims 2-5, 7-15, and 34, each of which depends either directly or indirectly from claim 1, should be reversed as well.

The rejection of independent claim 16 and its associated dependent claims is dealt with in more detail immediately below in section IV.C.

C. The Rejection of
Claims 16-18 and 20-23
Under 35 U.S.C. § 102/103

The Examiner's Answer modifies the rejection with respect to claims 16-18 and 20-23, transforming the rejection under 35 U.S.C. § 102 to an alternative rejection under 35 U.S.C. § 102/103.

Applicants/appellants have responded to the rejection under 35 U.S.C. § 102 in the aforementioned Reply to Office Action and in the Appeal Brief. In response to applicants/appellants' remarks, the Examiner modified the rejection under 35 U.S.C. § 102 to include an alternative ground of rejection under 35 U.S.C. § 103, although the Examiner did not designate the 35 U.S.C. § 103 as a new ground of rejection. Applicants/appellants respond herein to both the rejection under 35 U.S.C. § 102 and the rejection under 35 U.S.C. § 103. The rejection under 35 U.S.C. § 102 and the rejection under 35 U.S.C. § 103 should be reversed.

With respect to the rejection under 35 U.S.C. § 102, neither Kramer nor McCausland shows or suggests a plurality of trade execute keys wherein the keys are programmed to be individually assigned to a particular security available for trading. Applicants/appellants explained this in detail in the Appeal Brief starting at page 35, line 15 to page 37, line 3.

In fact, the Examiner's Answer acknowledges that "[w]hile both references explicitly disclose that the keyboard contains a plurality of trade execute keys (at least one buy and one sell key), it is not explicitly disclosed that the keyboard has a separate buy key and a separate sell key (i.e., a set of trade execute keys) assigned to each of a plurality of specific securities. . . ." Examiner's Answer page 7-8. Nevertheless, the Examiner has concluded that it is inherent that each of the programmable keys could be programmed as separate buy and sell keys for specific securities, or, at least, it would have been obvious to so program them.

Although the Examiner argues that trade execute keys according to the invention are inherent in McCausland or Kramer, anticipation by inherency requires that (1) the missing descriptive matter be "necessarily present" in the prior art reference and that (2) it would be so recognized by persons of ordinary skill in the art. Continental Can Co. USA v. Monsanto Co., 948 F.2d 1264, 1268, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991). The Examiner has already acknowledged the difference between trade execute keys according to the invention and the systems of McCausland and Kramer. Moreover, the Examiner has acknowledged that trade execute keys according to the invention are a design choice -- implying

that other choices, such as, for example, keys shown in McCausland. The keys in McCausland are used, among other things, to: identify an issue, which, in turn, creates an order display to allow changing the trade, adjust a trade, enter a trade, which, in turn, creates an order display to view the trade, and then confirm or reject keys which allow the trader to confirm such an order and enter it into the system or reject the order. These keys are possible for a designer of electronic trading systems. Because that is a recognition that other key assignments are possible, and because, inherency "'may not be established by probabilities or possibilities,'", it follows that trade execute keys according to the invention are not inherent in either Kramer or McCausland. See, Continental Can Co. USA v. Monsanto Co., 948 F.2d 1264, 1268-69, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991) (citations omitted).

In addition, in previous communications with applicants/appellants, the Examiner had raised an example of a fast-food restaurant keyboard as anticipating trade execute keys according to the invention. The Examiner has now acknowledged that the fast-food restaurant keyboard does not anticipate the claimed invention. Thus, in view of applicants/appellants' statements regarding (a) the improper rejection based on inherency in either McCausland or Kramer and (b) the Examiner's acknowledgment that the fast-food restaurant example does not show or suggest trade execute keys according to the invention, the rejection of claim 16, and its associated dependent claims, under 35 U.S.C. § 102 based on McCausland or Kramer should be reversed.

With respect to the Examiner's arguments under 35 U.S.C. § 103, the MPEP clearly states that "[t]o establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations." See MPEP §2143. The rejection under 35 U.S.C. § 103 fails to meet at least two of the three prongs required for a rejection under 35 U.S.C. § 103.

With respect to the requirement for a suggestion or motivation to modify the references or to combine reference teachings, the Examiner states in the answer that, "one would have been motivated to set up special buy and sell keys for specific securities in order to increase the speed in which the operator could enter selections as discussed as being desirous by both references." Examiner's Answer, page 8. However, the Examiner's Answer itself, at page 18, not only lacks such a motivation but acknowledges that the state of the art teaches away from such a motivation, stating, "[f]urthermore, the Examiner notes that if the trader of the Appellant's invention actively traded 10 or 20 such securities, the claimed keyboard, with separate buy and lift keys for each security, would quickly become too cumbersome to operate with any kind of efficiency. On such a system it would be much more efficient to have only one hit key and one lift key and to program the other functions keys for each

desired security." Examiner's Answer, page 18. Thus, the Examiner recognizes in the Answer that the art viewed "trade execute keys" according to the invention as "too cumbersome to operate with any kind of efficiency." Because one skilled in the art would be discouraged from following the path of the invention -- as acknowledged by the Examiner in the Answer itself -- it follows that no true suggestion or motivation exists to modify the references to make the invention and the first prong required for a *prima facie* case of obviousness has not been met.

In their invention, applicants/appellant chose the path discouraged by the prior art in order to obtain certain specific advantages. The advantages of the invention include increased trading speed for a select number of issues. The specification of the patent set forth these goals of the invention stating, "efficient input systems are important to effectuate the multiple options and the use of a highly specialized keypad that permits these levels of efficiency in the present context. Accordingly, a separate aspect of the present invention is the unique keypad depicted in FIG. 3." See, '974 patent, column 8, lines 31-36. FIG. 3 shows trade execute keys programmed to be individually assigned to a particular security available for trading.

The Examiner also argued that there is motivation in the prior art to provide "special buy and sell keys for specific securities in order to increase the speed in which the operator could enter selections as discussed as being desirous by both references." This does not contemplate trade execute keys according to the invention. Even if one skilled in the art were motivated to modify the keyboard in order to

increase trading speed, the prior art would have taught away from the claimed invention as follows.

In applicants/appellants' invention, the trade execute keys cause execution to occur without further action. This execution may occur at the price of the contra bid (or bids) or contra offer (or offers) currently in the system that the execution is acting upon.

In contrast, the prior art, such as McCausland, taught that a trader was given an opportunity to adjust a trade, was required to enter the trade, whether adjusted or not, and was required to confirm execution of the trade even after the trade was entered. While the Examiner stated that, "both references" contemplated increased speed, neither reference ever contemplated disposing of the trade adjustment, trade entry and confirmation functionality.

Kramer never contemplates disposing of this functionality because Kramer does not disclose a system that executes trades. Nor does McCausland ever contemplate disposing of the trade adjustment, trade entry and confirmation functionality. Rather, McCausland requires entering the desired trade and then "the order for the issue selected is displayed in a small window on the trader's page." See, McCausland, col. 23, lines 22-24. Following this display, the order must still be confirmed or rejected by the trader before it is sent. Finally, McCausland clearly teaches away from a system that provides immediate execution stating, "[i]f at any time prior to pressing [Confirm], a trader decides to change the transaction or wishes (sic) an error, press [Reject]." See McCausland col. 25, lines 4-7. Thus, there is no motivation to modify McCausland or any other

reference to provide trade execute keys according to the invention because the prior art teaches away from immediate execution.

Finally, as stated above with respect to the rejection under 35 U.S.C. § 102, trade execute keys according to the invention are not shown or suggested by the prior art references. Thus, because, none of the prior art references shows or suggests all the claim limitations, whether the references are taken alone or in combination with one another, the references do not meet all the limitations and the third prong required for a *prima facie* case of obviousness has also not been met.

The first and third prong of the *prima facie* obviousness case have not been met. Where, as here, the Examiner fails to establish a *prima facie* case of unpatentability, the applicant is entitled to grant of the patent. In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

For at least the foregoing reasons, the rejections of claims 16-18 and 20-23 under both 35 U.S.C. § 102 and under 35 U.S.C. § 103 should be reversed.

D. The Rejection of
Claim 31-33 and 35-37
Under 35 U.S.C. § 103(a)

The Examiner's Answer clarified the previous approach taken in rejecting claims 31-33 and 35-37 based on McCausland or Kramer in combination with the Official Notice taken of Dutch auctions. Presently, the Examiner's Answer combines an Officially-Noted fact "that it is old and well known in the negotiation and auction arts that third party participants can be allowed to participate (included) or

prevented from participating (excluded) during the negotiation and consummation of a transaction between the first and second parties" with each of the McCausland and Kramer references.

Applicants/appellants maintain the position set forth in the Appeal Brief at pages 47-48 -- i.e., that neither the Officially-Noted fact (which applicants/appellants continue to traverse)² nor the Dutch auction reference, in combination with either McCausland or Kramer shows or suggests the claimed invention.

It is clear that cited prior art fails to show a system involving multiple buyers and sellers, in which (1) trading takes place at a price defined by the initial hit or lift; (2) the first buyer and seller may trade their desired volume to the exclusion of another buyer or seller who wishes to trade at the defined price until a predefined event occurs; and (3) after the predefined event occurs, the other buyer or seller may trade but may not exclude others from trading at the defined price.

The first cited portion of McCausland (col. 20, lines 58-61) does not, contrary to the Examiner's statement, relate to confirming or rejecting a second party's bid or offer. Rather, the cited portion relates to confirming or rejecting an entry onto a trader's Personal Page. The trader's Personal Page assembles a list of only the issues the trader is interested in trading or monitoring.

Applicants/appellants have searched McCausland for the subject matter as set forth in the Examiner's Answer and have not

² Even the Examiner's Dutch auction reference does not show the "Officially-Noted fact" or the Examiner would have based the rejection on the Dutch auction reference itself.

found anything relating to confirming or rejecting a second party's bid or offer. Applicants/appellants have performed a word search in McCausland and the words "second party" do not appear in McCausland. The second cited portion of McCausland discusses the differences between a "single-order" trader and a "multi-order" trader (col. 22, lines 41-63) -- i.e., a trader with only one order on each side of an issue or multiple orders on each side of an issue. The third cited portion of McCausland discusses how partial hits or offers are handled (col. 24, line 64 - col. 25, line 3). From the above it is clear that nothing cited in McCausland relates to including a third participant without enabling the third participant to exclude others from participating in trading more volume at said price.

The single cited portion of Kramer discusses at length how the system alerts traders to an unreconciled trade record (col. 12, lines 38-61) and does not relate in any way to including or excluding traders. The Officially-Noted fact merely relates to including and excluding participants and does not provide any particular method of including or excluding participants. Therefore, at least the last element of each of claims 31 and 32 is not shown or suggested by the prior art references whether taken alone or in combination.

Furthermore, as applicants/appellants previously argued, (Appeal Brief, page 46-47), there is no motivation to combine McCausland or Kramer with a Dutch auction, and, in fact, the references teach away from the combination.

While the Examiner notes that applicants/appellants argued that the Examiner's cited motivation for combining McCausland and Kramer with the Officially-Noted fact taught

away from the invention, the Examiner does not address applicants/appellants' argument. Rather the Examiner alleges that because he has clarified the combination of each of McCausland and Kramer with the Officially-Noted fact to reject the claims, and only used the Dutch auction reference as support for the Officially-Noted fact, therefore, the lack of motivation to combine references was "mute" since the Dutch auction reference was not combined.

Applicants/appellants disagree.

Applicants/appellants directed their teaching away arguments to the motivation supplied by the Examiner in making the combination of the Officially-Noted fact with either McCausland or Kramer. See, Appeal Brief, page 47, lines 6-21. Thus, applicants/appellants did not limit their teaching away argument to the Dutch auction reference but, rather, directed their argument towards the motivation stated by the Examiner.³ The Examiner has failed to respond to this argument. The rejection of claims 31-33 and 35-37 should be reversed because of this lack of motivation as shown by the unrebutted teaching away of the combination stated by the Examiner.

³ It is also interesting to note that in the paragraph in the Final Office Action, See, Final Office Action, page 10-11, setting forth the motivation to combine the Officially-Noted fact with Kramer and McCausland, the Examiner cited the Dutch auction reference in support of the Officially-Noted fact. In the Examiner's Answer, however, the Examiner has alleged that a motivation to combine the Officially-Noted fact with McCausland or Kramer cannot be confused with a motivation to combine the Dutch auction reference with McCausland or Kramer. The Examiner has alleged further that any argument against combining the Dutch auction reference with McCausland and Kramer is mute with respect to arguing against the combination of the Officially-Noted fact with McCausland and Kramer.

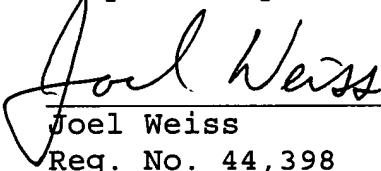
The Examiner has further extended the Official Notice. In the Examiner's Answer at page 22 to reject the subject matter of claim 36 which defines automatically executing the inhibited trade command if the period of time expires without the first and second participants transacting a trade. Yet the Examiner also notes that the Officially Noted fact, does not extend to such a teaching.⁴ Rather, the Examiner's Answer speculates that such a claimed invention is one of two possible actions that could be taken by the system. The mere fact that certain things may result from a given set of circumstances is not sufficient basis on which to sustain a rejection under 35 U.S.C. § 103. Ex parte Seiler and Seiler, 215 USPQ 742, 743 (PTO Bd. App. 1982). Therefore, the Official Notice with respect to claim 36 should be reversed at least because the Officially-Noted fact does not show or suggest all the limitations claimed invention and, as such, is an improper rejection under 35 U.S.C. § 103.

⁴ And again, the teaching is not in the Dutch auction reference or the Examiner would have based the rejection on the Dutch auction reference itself.

V. CONCLUSION

For at least the reasons set forth above -- i.e., that the last element in independent claim 1 is both supported and not anticipated, independent claim 16 is neither anticipated nor obvious in view of McCausland, Kramer or fast-food restaurant keyboards, and independent claims 31 and 32 include at least one element that is not shown, suggested or made obvious by any of the cited prior art references or combinations thereof -- applicants/appellants respectfully submit that this application is in condition for allowance. The Examiner's rejections should be reversed.

Respectfully submitted,



Joel Weiss

Reg. No. 44,398

Attorney for Applicants/Appellants

FISH & NEAVE IP GROUP

ROPES & GRAY LLP

Customer No. 1473

1251 Avenue of the Americas

New York, New York 10020-1105

Tel.: (212) 596-9000



Attorney Docket No. CF-007 Reissue

REISSUE PATENT APPLICATION

Reissue Applicants/Appellants :

Stuart A. Fraser et al.

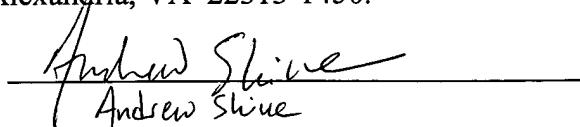
Application No.	:	09/859,661	Confirmation No.	3933
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For	:	AUTOMATED AUCTION PROTOCOL PROCESSOR		
Examiner	:	James W. Mhyre		
Group Art Unit	:	3622		

New York, New York 10020
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Andrew Shue

Encl:

- Supplemental Information Disclosure Statement (in duplicate);
- Reply to Examiner's Answer;
- PTO/SB/08A (in duplicate);
- Twenty (21) One cited references; and

Check in the amount of 180.00.